

Serial No. 10/708,839
Attorney Docket No. 70655.0300

REMARKS

Applicants reply to the Office Action mailed on November 21, 2005, within two months. Thus, Applicants request an Advisory Action, if necessary. The Examiner rejects claims 1-17. Applicants amend claims 1, 4, 14, and 17 and add new claims 18-21, so claims 1-21 are now pending in the application. Support for the amendments may be found in the originally-filed specification, claims, and figures. No new matter has been introduced by these amendments. Applicants assert that the subject matter of the various claims was commonly owned at the time the inventions covered therein were made and therefore, Applicants have complied with 37 C.F.R. § 1.56.

DOUBLE PATENTING

The Examiner provisionally rejects claims 1-17 over claims 1-17 of co-pending Application Serial No. 10/710,332. While Applicants respectfully disagree with this double patenting rejection, in the interest of compact prosecution, Applicants submit a terminal disclaimer, without prejudice, in compliance with 37 C.F.R. § 1.321(c). Applicants also assert that this non-statutory double patenting rejection is based on the above-listed application, which is commonly owned with this application by assignee, American Express Travel Related Services Company, Inc.

CLAIM OBJECTIONS

Claim 14 has been amended as suggested by the Examiner. Thus, the objection is now moot.

35 U.S.C. § 103 REJECTIONS

The Examiner rejects claims 1-17 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,925,656 ("Black") in view of U.S. Patent Application No. 2005/0098621 ("de Sylva"). Applicants respectfully traverse this rejection. Applicants' amendment to independent claim 1 renders this rejection moot. As indicated by the Examiner in the Office Action dated November 29, 2005 regarding claim 11 of application no. 10/710,308, "verifying whether the sample is associated with a preset transaction limit" is non-obvious.

Neither Black, de Sylva, nor any combination thereof, disclose or suggest at least a "method for registering biometric information for use in a transponder-reader system, said

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method comprising: . . . associating said proffered biometric sample with a transaction limitation," as recited in amended claim 1.

Accordingly, Applicants assert that claim 1 is patentable over the cited references. Similarly, claims 2-17 depend from claim 1 and contain all of the elements thereof. Therefore, Applicants assert that claims 2-17 are differentiated from the cited reference at least for the same reasons as set forth above, in addition to their own respective features. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 2-17.

NEW CLAIMS 18-21

New claims 18-21 variously depend from claim 1 and contain all of the elements thereof. Therefore, Applicants assert that new claims 18-21 are differentiated from the cited references at least for the same reasons as set forth above, in addition to their own respective features.

CONCLUSION

Applicants respectfully submit that the pending claims (21 claims total, 1 independent) are in condition for allowance. Reconsideration of the application is thus requested. **The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. 19-2814.** Applicants invite the Examiner to telephone the undersigned if the Examiner has any questions regarding this Reply or the application in general.

Respectfully submitted,

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